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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,925	12/05/2001	Carl Phillip Gusler	AUS920011013US1	9805

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EXAMINER	
NEURAUTER, GEORGE C	

ART UNIT	PAPER NUMBER
2143	

DATE MAILED: 01/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/004,925	GUSLER ET AL.	
	Examiner	Art Unit	
	George C. Neurauter, Jr.	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 December 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *02192002*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-30 are currently presented and have been examined.

Claim Objections

1. Claims 9, 19, and 29 are objected to because of the following informalities:

Claims 9, 19, and 29 recite "...date/time distribution of instant messages, tracking of contact patterns..." The statement should read "...date/time distribution of instant messages, and tracking of contact patterns..."

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 7, 8, 11, 17, 18, 21, 27, and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Application Publication 2002/0004907 A1 to Donahue.

Regarding claim 1, Donahue discloses a method of monitoring use of an instant messaging user account, comprising:

receiving an instant message (referred to within the reference as "chat session"; paragraph 0004); storing a transcript ("log") of the instant message in a storage device; (paragraph 0011)

analyzing ("processing") the transcript for occurrences of questionable content to thereby identify at least one portion of the transcript having questionable content; (paragraphs 0015, 0016 and 0018) and

providing the at least one portion of the transcript to a designated monitor of the instant messaging user account ("user"). (paragraph 0006, last sentence)

Regarding claim 7, Donahue discloses the method of claim 1, wherein providing the at least one portion of the transcript to a designated monitor includes generating a web page through which the at least one portion of the transcript is provided to the designated monitor. (paragraph 0028)

Regarding claim 8, Donahue discloses the method of claim 1, further comprising:

identifying at least one transcript characteristic ("category") of the transcript; updating at least one instant messaging account characteristic ("keyword match") based on the

at least one transcript characteristic; (paragraphs 0015 and 0016) and

providing the at least one instant messaging account characteristic to the designated monitor of the instant messaging account. (paragraph 0028)

Claims 11, 17, and 18 are rejected since these claims recite an apparatus that contain substantially the same limitations as recited in claims 1, 7, and 8 respectively.

Claims 21, 27, and 28 are rejected since these claims recite a computer program product that contain substantially the same limitations as recited in claims 1, 7, and 8 respectively.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 2-6, 10, 12-16, 20, 22-26, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donahue.

Regarding claim 2, Donahue discloses the method of claim 1.

Donahue does not expressly disclose wherein the method is implemented in an instant messaging service provider of a distributed data processing system, however, Donahue does disclose wherein the method may be implemented anywhere where

the monitoring is able to be implemented (paragraph 0006, the sentence "The present invention monitors...")

It would have been obvious to one skilled in the art at the time the invention was made to implement the method in an instant messaging service provider because the Applicant has not disclosed that using the limitation undisclosed in Donahue provides any sort of an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the method described in Donahue as recited in the claim because, in view of the disclosures of Donahue, the method may be implemented anywhere where the communication may be monitored and it would have been obvious to have the method execute anywhere within a network system as the method would work equally well regardless of where the method is implemented.

Regarding claim 3, Donahue discloses the method of claim 1.

Donahue does not expressly disclose wherein the method is implemented in a network service provider of a distributed data processing system, however, Donahue does disclose wherein the method may be implemented anywhere where the monitoring is able to be implemented (paragraph 0006, the sentence "The present invention monitors...")

Claim 3 is rejected since the motivations regarding the obviousness of claim 2 also apply to claim 3.

Regarding claim 4, Donahue discloses the method of claim 1.

Donahue does not expressly disclose wherein the method is implemented in a client device of a distributed data processing system, however, Donahue does disclose wherein the method may be implemented anywhere where the monitoring is able to be implemented (paragraph 0006, the sentence "The present invention monitors...")

Claim 4 is rejected since the motivations regarding the obviousness of claim 2 also apply to claim 4.

Regarding claim 5, Donahue discloses the method of claim 1.

Donahue does not expressly disclose wherein providing the at least one portion of the transcript to a designated monitor includes transmitting the at least one portion of the transcript as an attachment to an electronic mail message, however, Donahue does disclose providing the at least one portion of the transcript to a designated monitor by transmitting the at least one portion of the transcript as a web page or other means (paragraph 0006, last sentence; paragraphs 0028 and 0029). Donahue also contemplates the use of attachments within an email (paragraph 0014, specifically the sentence "For instance, email may contain...")

It would have been obvious to one skilled in the art at the time the invention was made to use the method of transmitting the at least one portion of the transcript by a web page because the Applicant has not disclosed that using the limitation undisclosed in Donahue provides any sort of an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the method of transmitting described in Donahue as recited in the claim because the transcript can be received by the user regardless of the manner the transcript is sent.

Regarding claim 6, Donahue discloses the method of claim 5.

Donahue does not disclose wherein the electronic mail message is transmitted in response to a request from the designated monitor, however, Donahue does disclose wherein the at least one portion of the transcript is transmitted in response to a request from the designated monitor (paragraph 0006, last sentence; paragraph 0028)

Claim 6 is rejected since the motivations regarding the obviousness of claim 5 also apply to claim 6.

Regarding claim 10, Donahue discloses the method of claim 1.

Donahue does not expressly disclose wherein analyzing the transcript includes filtering for text including at least one of proper names, addresses and phone numbers, however, Donahue does disclose wherein analyzing the transcript includes filtering for text (paragraphs 0017 and 0018). Donahue discloses that any text may be filtered (paragraphs 0015, the sentences "The remainder..." and "This allows the language elements...").

It would have been obvious to one skilled in the art at the time the invention was made to use the method of analyzing the transcript by filtering for any text because the Applicant has not disclosed that using the limitation undisclosed in Donahue provides any sort of an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the method of filtering described in Donahue as recited in the claim because any text may be filtered regardless of the sort or type of text to be filtered in view of the disclosures of Donahue.

4. Claims 9, 19, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donahue as applied to claim 1 above, and further in view of US Patent Application Publication 2002/0032770 to Fertell et al.

Regarding claim 9, Donahue discloses the method of claim 8.

Donahue does not disclose wherein the at least one instant messaging account characteristic includes at least one of a ranked list of user identifications for most frequent incoming instant messages, a ranked list of user identifications for most frequent outbound target user identifications, a ranked list of most frequent recent incoming or outbound user identifications, a date/time distribution of instant messages, tracking of contact patterns for a particular user identification, however, Donahue does disclose a instant messaging account characteristic ("keyword match"; paragraphs 0015 and 0016). Donahue also suggests that other instant messaging account characteristics may be used (paragraph 0028, the sentences "To enhance ease-of-use..." and "In addition, all bar graph...")

Fertell discloses a instant messaging account characteristic which includes a date/time distribution of instant messages (paragraphs 0010 and 0035).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of these references since Fertell discloses that using a date/time distribution enables a date/time reference to be stored with the transcript ("log") (paragraph 0035, last paragraph). In view of these specific advantages and that both references are directed to monitoring use an instant messaging

account, one of ordinary skill would have been motivated to combine these references and would have considered them to be analogous to one another based on their related fields of endeavor.

Claims 19 and 29 are also rejected since these claims recite an apparatus and computer program product that contain substantially the same limitations as recited in claim 9.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following prior art generally teaches the state of the art in monitoring network communications and instant messaging systems:

US Patent 6 076 100 to Cottrille et al;

US Patent 6 519 639 to Glasser et al;

US Patent 6 631 412 to Glasser et al;

US Patent 6 691 162 to Wick;

US Patent Application Publication 2002/0049806 to Gatz et al;

US Patent Application Publication 2002/0073150 to Wilcock;

US Patent Application Publication 2002/0143916 to Mendiola et al;

US Patent Application Publication 2003/0078972 to Tapissier et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is (571) 272-3918. The examiner can normally be reached on Monday through Friday from 9AM to 5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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